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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/893,209 | 09/19/2001 | Song Kim | 7091-103/10102873 | 5641 |

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FULBRIGHT & JAWORSKI L.L.P.
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EXAMINER

NGUYEN, TRINH T

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 12/11/2002

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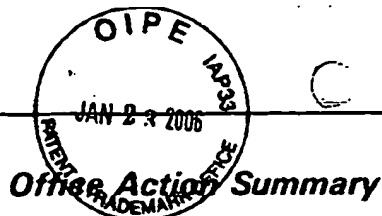
DEC 18 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED FOR
2/11/03 OAR
3/11/03 ZRD
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TECHNOLOGY CENTER B3700



Application No.
09/893,209

Applicant(s)
Kim

Examiner
Trinh Nguyen

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3728

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 8, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above, claim(s) 4-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Continued Examination under 37 CFR 1.114 After Final Rejection

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/8/02 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serwer (US 3,030,696) in view of Tramont (US 5,693,141).

As shown in clearly in Figures 1, 2, and 4, and lines 1-55 of col. 2, Serwer clearly discloses all the limitations as claimed except for: 1) a natural sponge member formed on the roller tube having natural sponge protrusions capable of applying paint to a surface in a positive

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design form; and 2) the base material comprises cotton. Note that Serwer's roller tube has at least one end being open since an end cap (23) is being inserted on this open end (see Figure 4).

Regarding 1) a natural sponge member formed on the roller tube...capable of applying paint to a surface in a positive design form, Tramont teaches the use of a natural sponge member formed on the roller tube wherein the natural sponge member having sponge protrusions capable of applying paint to a surface in a positive design form (see lines 60-63 of col. 8, lines 1-10 of col. 9, and Figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced Serwer's synthetic sponge-like lamina 12 with a natural sponge member, as taught in Tramont, in order to save the cost of manufacturing a synthetic sponge member, and since Tramont states that the material can be either synthetic sponge or natural sponge (see lines 60-65 of col. 8).

Regarding 2), Serwer teaches the use of a backing/base layer as claimed, but made of "substantially non-elastic material, such as paper or others suitable flexible non-elastic sheeting" (see lines 1-8 of col. 2). Cotton is in this category. Furthermore, Applicant acknowledges that other materials can be used as the backing/base material (i.e., fabric, plastic sheets, natural or synthetic rubber) (see paragraph [0020] of page 4 of the specification). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the backing/base material is a matter of design choice, wherein no significant problem is solved, or unexpected result obtained by constructing the backing/base material out of either cotton, or fabric, or plastic sheets, or rubber as claimed versus the backing/base material utilized by Serwer,

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since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Response to Arguments

4. Applicant's arguments filed 11/8/02 have been fully considered but they are not persuasive.
5. Applicant argues that Serwer does not teach a natural sponge member of predetermined thickness, the Examiner agrees. However, as described above in paragraph #3, the reference Tramont was cited to show that using "a natural sponge" member in a paint roller is old and well known. Furthermore, note that Tramont's roll medium (which is equivalent to Applicant's "member" as claimed in claim 1) is provided from either a separate blank material (which means that the blank material is being cut to a predetermined thickness and/or shape) or a continuous blank material (which means that the blank material is from a roll of sheet material that is not being cut).
6. Applicant further argues that there is nothing to suggest the use of a strip of natural sponge member onto the roller tube of Serwer, the Examiner disagrees. In this case, the Serwer reference teaches the use of a strip of "sponge-type" material onto a paint roller and the Tramont reference teaches the use of a strip of "natural sponge" material onto a paint roller. Therefore, it would have been obvious to one of ordinary skill in the art to replace Serwer's "sponge-type" material with Tramont's "natural sponge" material, since it would be a matter of design choice of material selection.

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7. Applicant further argues that Tramont does not teach the strip being wound diagonally on the roller tube, the Examiner disagrees. In lines 22-27 of col. 5, Tramont teaches that the preformed shape (which is equivalent to the strip as claimed) is wrapped spirally around elongated core stock (which is equivalent to the roller tube as claimed).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh Nguyen whose telephone number is (703) 306-9082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

ttn

December 10, 2002

J. C. R.
An 372c